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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/815,317	03/22/2001	Timothy R. Kane	END9 2000 0168 US1	4656
44755 7590 01/16/2007 SHELLEY M. BECKSTRAND PATENT ATTORNEY 61 GLENMONT ROAD WOODLAWN, VA 24381			EXAMINER O'CONNOR, GERALD J	
			ART UNIT 3627	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
3 MONTHS			01/16/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/815,317	Kane et al.	
	<b>Examiner</b>	<b>Art Unit</b>	
	O'Connor	3627	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on November 3, 2005 (RCE) and September 29, 2005 (Amdt).
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 4, 8, and 9 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 8, and 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on March 25, 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 29, 2005 has been entered.

### ***Preliminary Remarks***

2. This Office action responds to the amendment and arguments filed by applicant on September 29, 2005 in reply to the previous Office action on the merits, mailed August 11, 2005.

3. The amendment of claims 1, 4, 8, and 9 by applicant in the reply filed on September 29, 2005 is hereby acknowledged.

### ***Response to Amendment***

4. The amendment submitted September 29, 2005 fails to comply with 37 CFR 1.121(c) because it fails to indicate any changes to "currently amended" claim 4 and because it fails to indicate any status for claim 5. The paper has been entered, but all future amendments *must* comply with 37 CFR 1.121.

*Claim Rejections - 35 USC § 101*

5. The following is a quotation of 35 U.S.C. 101:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. To be considered statutory, claimed subject matter requires four things<sup>1</sup>:

(1) the claimed subject matter *must* lie within the ambit of the *four classes* of statutory subject matter enumerated in 35 U.S.C. 101, those being any new and useful *process, machine, manufacture, or composition of matter*;

(2) the claimed subject matter *must not* fall within any of the *three categories* of statutory subject matter *exceptions* enumerated by the courts, those being, *in the absence of any practical application: abstract ideas, laws of nature, and natural phenomena*;

(3) any *practical application* of one of the three *otherwise nonstatutory* categories of exceptions *must not preempt* the underlying abstract ideas, laws of nature, or natural phenomena by foreclosing others from *substantially all other practical applications* of the *same* abstract ideas, laws of nature, or natural phenomena; *and*,

(4) any *practical application* of one of the three *otherwise nonstatutory* categories of exceptions *must* be evidenced in at least one of two possible ways:

(a) by transforming an article or physical object to a different state or thing; or,

(b) by otherwise producing any useful, concrete, and tangible result.

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<sup>1</sup> *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*, published by order of the Commissioner for Patents, available in pdf format online on the Internet at: [http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101\\_20051026.pdf](http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf).

7. Claims 1, 4, 8, and 9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Method claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Method claim 1 fails to satisfy the fourth, and thus the second, requirements for statutory subject matter eligibility because it is considered to be drawn merely to a method of producing a disembodied data structure. It has been held that such claims are considered to comprise non-statutory subject matter, for merely manipulating an abstract idea without producing any “useful, concrete, and tangible result.” *In re Warmerdam*, 33 F.3d 1354; 31 USPQ2d 1754 (Fed. Cir. 1994). Moreover, method claim 1 fails to satisfy the third requirement for statutory subject matter eligibility because it is considered to *preempt* the underlying abstract idea, since it would foreclose others from *substantially all practical applications* of the *same* abstract idea. It has been held that such claims are considered to be unpatentable for comprising non-statutory subject matter. *In re Schrader*, 22 F.3d 290, 295; 30 USPQ2d 1455, 1459 (Fed. Cir. 1994).

Claims 4 and 8 are considered to be drawn to a *practical application* of an *abstract idea*, one of the three *otherwise nonstatutory* categories of *exceptions*, thereby meeting the first, second, and fourth requirements for statutory subject matter eligibility. *However*, claims 4 and 8 fail to satisfy the third requirement for statutory subject matter eligibility because they are considered to *preempt the underlying abstract idea*, since they would foreclose others from *substantially all other practical applications* of the *same* abstract idea. It has been held that such claims are considered to

be unpatentable for comprising non-statutory subject matter. *In re Schrader*, 22 F.3d 290, 295; 30 USPQ2d 1455, 1459 (Fed. Cir. 1994).

Claim 9 is drawn to a computer program *per se*. Computer programs *per se* intrinsically require no tangible physical structure, thus do not constitute tangible physical articles or other forms of matter. Therefore, computer programs *per se* are not considered to be statutory subject matter. To be statutory, a computer program must be: (1) coupled with or combined with some statutory physical structure, *and*, (2) produce or effect some useful, concrete, and tangible result.

***Claim Rejections - 35 USC § 112, First Paragraph***

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for performing the recited functionality by machine, does not reasonably provide enablement for *all* possible methods of performing the various recited steps, including entirely manually and/or mentally. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention *commensurate in scope* with these claims. See MPEP § 2164.08.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1, 4, 8, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gardner et al. (US 5,758,327).

Gardner et al. disclose a procurement accounting system for a plurality of customer companies of an enterprise providing procurement services, comprising: a back-end procurement system; a front-end requisition and catalog system; a first chart of accounts store maintained in said procurement system; a second chart of accounts maintained in said requisition and catalog system of a given customer company which differs from a chart of accounts for a different company of said customer companies; an extract utility at said procurement system for periodically extracting from said first chart of accounts, account identification indicia and descriptive information for a given company; an update utility at said requisition and catalog system for associating said account identification indicia with commodity codes and company codes; a data store for storing said indicia and information; a company table for storing company identifiers associated with each of a plurality of company codes; said update utility further for pushing to all companies associations of commodity codes and account identification indicia entered for a given company within said company codes; and an output device responsive to a



user request for a purchase of a commodity for displaying a selection list of valid account codes and descriptive information for said company code, but Gardner et al. do not disclose that each customer company comprises a group of companies sharing a common chart of accounts.

However, arranging a company structure so as to have a company comprise a group of companies, with all companies in the group of companies sharing a common chart of accounts for procurement activities is certainly a well known, hence obvious, arrangement to make for those of ordinary skill in the art, and official notice to that effect is hereby taken. For example, it is not uncommon for several different companies to be owned by one corporate parent company, and for the parent company to arrange/negotiate for procurement contracts with favored suppliers, using economies of scale and the combined purchasing power of the entire group of companies for leverage in order to negotiate the most favorable rates with the suppliers.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Gardner et al. so as to accommodate the well known corporate arrangement of each company comprising a group of companies/divisions/entities, in order to provide procurement services to such customers by accommodating the corporate structure of such companies/customers, and since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.



***Response to Arguments***

12. Applicant's arguments filed September 29, 2005 have been fully considered but they are not deemed persuasive.

13. The arguments regarding the previous prior art rejections have been considered, but have been rendered moot by applicant's amendment, and the consequent new grounds of rejection.

***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to the disclosure.

15. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(571) 272-6787**, and whose facsimile number is **(571) 273-6787**.

Official replies to this Office action may now be submitted electronically by registered users of the EFS-Web system. Information on EFS-Web tools is available on the Internet at:

<http://www.uspto.gov/ebc/portal/tools.htm>. An EFS-Web Quick-Start Guide is available at:  
<http://www.uspto.gov/ebc/portal/efs/quick-start.pdf>.

Alternatively, official replies to this Office action may still be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies should be directed to the central fax at (571) 273-8300.**

Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA

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22313-1450." Hand delivered replies should be delivered to the "Customer Service Window,  
Randolph Building, 401 Dulany Street, Alexandria, VA 22314."

GJOC

January 8, 2007



1/8/07

Gerald J. O'Connor  
Primary Examiner  
Group Art Unit 3627